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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,043	11/04/2003	Derek Campbell	005127.00179	3120
22909	7590	10/15/2009	EXAMINER	
BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			MAI, TRI M	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/700,043	<b>Applicant(s)</b> CAMPBELL ET AL.	
	<b>Examiner</b> Tri M. Mai	<b>Art Unit</b> 3781	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-38,40-60 and 68-76 is/are pending in the application.  
     4a) Of the above claim(s) 56-60 and 68-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-38 and 40-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

Art Unit: 3781

1. In order to simplify issues before the Board of Appeal and Interferences, the examiner hereby withdrawn some rejections as set forth in the Final Office Action dated 02/07/08.

Applicant is required modify the Brief to reflect this office action. Applicant is noted that there are also several issues in the Appeal Brief dated 05/01/09: a) Applicant is require to include the identifiers in the all of the claims before the Board of Appeal and Interferences, b) Applicant is required to include a copy of the Declaration as an appendix to the case.

2. Claims 1, 4-11, 15-16, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102 (e) as being anticipated by Cheng (6938762). Cheng '762 teaches a golf bag having a base 20 including a one-piece element (col. 2, ln. 21) that extend around the second of the body and forms a support surface and defining a flexion line 224 defining two pivotable portions.

Regarding claim 7, there is a reduced thickness at the joint.

3. Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng (6386362). Cheng '362 teaches a golf bag having a base including a one-piece element 2 that extend around the second of the body and forms a support surface and defining a flexion line 42 defining two pivotable portions.

Cheng '362 clearly teaches a one piece base with the pivot section 40 is molded together with the base:

**a one-piece, molded, flexible pivot section** including bridging portions bridging the V-shaped notches between the first and second upstanding walls, and **a rib portion extending between the bridging portions and pivotally connecting the first and second bottoms** whereby the first and second sections of the base seat may pivot relative to each other (claim 1, emphasis added)

**The pivot section 40 is made by injection molding.** The periphery of the pivot section 40 is bridged between the edges of the lateral side and bottom face of the adjacent open portions of the front and rear

Art Unit: 3781

sections 20, 30 so as to connect the first and second receiving rooms 22, 32. The pivot section 40 is further formed with a rib 42 slightly projecting from inner bottom face of the base seat 2. The pivot section 40 is made of well flexible plastic or rubber material, whereby the front and rear sections 20, 30 can be swung about the pivot section 40 by a certain amplitude. (col. 3, ln. 11-20, emphasis added)

Even it is argued that Cheng ‘362 does not teach the base being single molded piece, the examiner submits that the base in Cheng ‘362 still anticipates the claims since the recitation “formed of a single piece” is broad and does not exclude the base made from a plurality of elements.

4. Claims 1, 4, 5, 6, 7, 8-11, 15-16, 18, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Te-Pin (6568527). Te-Pin teaches a golf bag having a base 1 (Fig. 1) including a one-piece element that extend around the second of the body and forms a support surface and defining a flexion line 50 defining two pivotable portions. Note that the recitation “formed of a single piece” is broad and does not exclude the base made from a plurality of elements.

5. Claims 2, 29-30, 38, 40-43, 46, and 47 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the Cheng and Te-pin rejections as set forth in paragraphs 2-4, and further in view of Kang (2004/0200746). The Cheng and Te-pin references, as applied in paragraphs 2-4 meets all claimed limitations except for the material for the base being made ethylvinylacetate foam.

6. Claims 12-14, 31-32, 35-37, 44, and 45 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cheng and Te-pin rejections as set forth in paragraphs 2-4, and further in view of Wen-Chien (6298988). The Cheng and Te-pin references, as applied in paragraphs 2-4 meets all claimed limitations except for wear elements and the material being made from rubber.

Art Unit: 3781

Wen-Chien also teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3 in two different configurations, i.e., one being larger and having a different shape than the other. It would have been obvious for one of ordinary skill in the art to provide wear elements as taught by Wen-Chien, an alternative supporting means and or to keep the bag secured and to grip the standing surface easily.

With respect to the material being rubber, it would have been obvious to one of ordinary skill in the art to make the feet of Wen-Chien from rubber as claimed since rubber is a well known material for providing contact between objects and the ground.

7. Claims 17-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cheng and Te-pin rejections, as set forth above in paragraphs 2-4, and further in view of view of Yoshida (6736264). The Cheng and Te-pin rejections, as applied in paragraphs 2-4, each teaches the base as disclosed, but does not teach a handle. Yoshida teaches that it is known in the art to provide a handle for a golf bag. It would have been obvious to one of ordinary skill in the art to provide a handle as taught by Yoshida '264 to handle the golf bag easily.

8. Claims 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Cheng and Te-pin rejections, as set forth above in paragraphs 2-4, in view of Wen-Chien, and Kang each teaches a bag bottom with feet in different configurations. They do not mention the bottom being made from foam material and the wear elements. Kang teaches that it is known in the art to make the base from ethylvinylacetate foam (para. 17). It would have been obvious for one of ordinary skill in the art to make the lower base segment from ethylvinylacetate foam to provide the desired material for the base.

Art Unit: 3781

With respect to the wear elements, Wen-Chien also teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3. The wear elements having two different configurations, one is smaller than the other as shown in Fig. 3. It would have been obvious for one of ordinary skill in the art to provide separate wear elements as taught by Wen-Chien to provide an alternative feet structure for the bag and to grip the standing surface easily.

With respect to the material being rubber, it would have been obvious to one of ordinary skill in the art to make the feet of Wen-Chien from rubber as claimed since rubber is a well known material for providing contact between objects and the ground.

#### **(10) Response to Argument**

Appellants's arguments and the declaration filed 03/19/2007 have been fully considered but they are not persuasive.

A. With respect to claims 1, 4-11, 15-16, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102 (e) as being anticipated by Cheng (6938762).

A1. Appellants rely on the Declaration of the inventors under 37 CFR § 1.131 filed March 19, 2007 to establish a date of conception and reduction to practice prior to May 28, 2003.

37 CFR 1.131. Affidavit or declaration of prior invention.

(a) **When any claim of an application** or a patent under reexamination is rejected, **the inventor of the subject matter of the rejected claim**, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

Art Unit: 3781

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. **Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained (emphasis added)**

A2. In the affidavit, paragraph 4, appellants asserts that the invention in at least claims 1, 4-11, 15, 16, 20-28, 33, 34, and 36 was conceived and reduced to practice prior to May 28, 2003. The affidavit, paragraph 6, asserts that the conception and reduction to practice of a single piece base with an inside indentation in the base and pivotable about the flexion line for claims 1 and 20. Paragraph 7 asserts the conception and reduction to practice a single piece base for claims 4-11, 15, 16, 21-28, 33, 34, and 36. The examiner submits that at least claims 25, 34, 36 are not supported at all by this assertion, i.e., none of the exhibit show the reduced thickness at the interface, and the shaft (22) extends between the upper portion and the base. The examiner submits that the declaration, as a whole, is defective and cannot overcome the Cheng '762 reference.

Art Unit: 3781

B. Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng (6386362).

B1. Appellants assert that Cheng '362 fails to teach the base "formed of a single piece".

B2. Cheng '362 clearly teaches a one piece base with the pivot section 40 is molded together with the base:

**a one-piece, molded, flexible pivot section** including bridging portions bridging the V-shaped notches between the first and second upstanding walls, and **a rib portion extending between the bridging portions and pivotally connecting the first and second bottoms** whereby the first and second sections of the base seat may pivot relative to each other (claim 1, emphasis added)

**The pivot section 40 is made by injection molding.** The periphery of the pivot section 40 is bridged between the edges of the lateral side and bottom face of the adjacent open portions of the front and rear sections 20, 30 so as to connect the first and second receiving rooms 22, 32. The pivot section 40 is further formed with a rib 42 slightly projecting from inner bottom face of the base seat 2. The pivot section 40 is made of well flexible plastic or rubber material, whereby the front and rear sections 20, 30 can be swung about the pivot section 40 by a certain amplitude. (col. 3, ln. 11-20, emphasis added)

B3. Appellants assert that the two halves must be connected by separate parts. The examiner submits that Cheng teaches a plurality of embodiments other than the anticipated embodiment where the flexible pivot section is molded together with the two halves as set forth above.

B4. To the degree it is argued that Cheng '362 does not teach the base being a single molded piece, the examiner submits that the base in Cheng '362 still anticipates the claims since the recitation "formed of a single piece" is broad and does not exclude the base made from a plurality of elements. Furthermore, the specification uses the term "one-piece element" (pg. 5, para. 29) and sheds no light on the recitation "single piece collar".



Art Unit: 3781

B5. The examiner submits the evidence from the Keller et al. (US 5501328), where in a “single piece collar” is made up from a plurality of parts.

FIG. 10 illustrates an alternative embodiment of the cover 28 wherein the inner and outer portions 30 and 32 thereof are joined together so that the cover 28 is made **as a one-piece item. (col. 3, ln 13, emphasis added).**

B5. The base, as defined by specification of the present application, comprised of plurality of elements (pg. 9, par. 37):

Base 40 includes a contact element 30 and a plurality of connecting elements 60a-60t; as depicted in Figures 5-11C. (pg. 9, para. 37)

Issue C: Claims 1, 4-11, 15-16, 18, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Te-Pin (6568527).

C1. Regarding claims 1 and 20, the issue is whether the base of Te-Pin meets the recitation “formed of a single piece”. The issue has been addressed and discussed above in issue B.

Issue D: Claims 2, 29-30, 38, 40-43, 46, and 47 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the Cheng and Te-pin rejections as set forth in issues B-D, and further in view of Kang (2004/0200746).

9. D1. Kang teaches that it is known in the art to make the base from ethylvinylacetate foam (para. 17). Therefore, it would have been obvious for one of ordinary skill in the art to make the lower base segment from ethylvinylacetate foam to provide the desired material for the base.

Art Unit: 3781

Issue E: Claims 12-14, 31-32, 35-37, 44, and 45 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cheng and Te-pin rejections, and further in view of Wen-Chien (6298988).

F1. Wen-Chien also teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3 in two different configurations, i.e., one being larger and having a different shape than the other. It would have been obvious for one of ordinary skill in the art to provide wear elements as taught by Wen-Chien, an alternative supporting means and or to keep the bag secured and to grip the standing surface easily.

Issue F: Claims 17-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cheng '762, Cheng '362, or Cheng '937, and further in view of view of Yoshida (6736264).

F1: Yoshida teaches that it is known in the art to provide a handle for a golf bag. It would have been obvious to one of ordinary skill in the art to provide a handle as taught by Yoshida '264 to handle the golf bag easily.

Issue G: Claims 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng and Tepin rejections, in view of Wen-Chien, and further in view of either Kang '746.

G1. Appellants assert that none of the references teaches the first and second wear elements having two separate configurations.

G2. The examiner also submits that the specification fails to shed light in what is meant by "first configuration" and "second configuration" other than the different shapes that is presented

Art Unit: 3781

in the drawings. In this respect, the term "configuration" is interpreted as having a specific shape. Wen-Chien teaches the two configurations as discussed supra.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on M-F 6 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3781

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tri M Mai/  
Primary Examiner, Art Unit 3781